

Docket No. 10004809-1
Application No. 10/783,610

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REMARKS

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Claims 1-5, 7-14 and 36-49 are pending in this present application. Claims 15-35 have been withdrawn from consideration as being drawn to a non-elected invention. Reconsideration of the application is respectfully requested in view of the following responsive remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

In the office action dated March 18, 2008, the following actions were taken:

(1) claims 1-5, 7-13, and 49 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,849,149 (hereinafter "Otaki") in view of U.S. Patent No. 4,893,887 (hereinafter "Coates");

(2) claim 14 was rejected under 35 U.S.C. 103(a) as being unpatentable over Otaki in view of Coates; and

(3) claims 36-48 were rejected under 35 U.S.C. 103(a) as being unpatentable over Otaki in view of Coates.

It is respectfully submitted that the presently pending claims be examined and allowed.

Rejections under 35 U.S.C. § 103(a)

Claims 1-5, 7-13, and 49

The Examiner rejected claims 1-5, 7-13, and 49 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,849,149 (hereinafter "Otaki") in view of U.S. Patent No. 4,893,877 (hereinafter "Coates"). In response to this rejection, Applicant submits that a *prima facie* case of obviousness has not been presented for these claims, as the references lack a teaching of each and every element of the claims. Of this particular set of claims, Claim 1 is independent and the remaining claims all depend from and are narrower in scope than claim 1. Accordingly, Applicant directs the following remarks to Claim 1 and any and all claims depending therefrom.

Independent Claim 1 requires a durable printed composite material as set forth above, wherein at least one of the layers includes an additive configured for one of light stabilization, liquid resistance, or vapor resistance. The Examiner alleges that Otaki discloses a colored transparent film 203 (col. 35, line 12), and that the colorant used to make this layer

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colored is equivalent to the claimed additives configured for light stabilization, liquid resistance and/or vapor resistance. See March 18, 2008 Office Action, page 2, paragraph 4. In response, Applicant has argued and maintains the position that the colorant of Otaki is not equivalent to the claimed additives. There is nothing in Otaki to teach or suggest that the colorant is also an additive configured for light stabilization, liquid resistance or vapor resistance. Despite there being *nothing* in Otaki that teaches or suggests that the colorant is also an additive consistent with those claimed in Claim 1, the Examiner argues the colorant of Otaki "*inherently* absorbs light having some wavelength, and by absorbing the light with some wavelength the product is protected from long term degradation from exposure to light." See March 18, 2008 Office Action, page 4, paragraph 7 (emphasis added).

Respectfully, Applicant disagrees with the Examiner's analysis and ultimate conclusion. First, the Examiner has based the rejection on a non-disclosed, allegedly *inherent* characteristic of the colorant in Otaki. Pursuant to MPEP §2112(IV), the Examiner must provide rationale or evidence tending to show inherency. In addition, the evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The Examiner has not provided evidence in this case to show that the colorant of Otaki inherently stabilizes a composition when exposed to light, resists liquid or resists vapor. Even if a colorant inherently absorbs light, it does not follow that the absorption of light inherently stabilizes a composition from light exposure, resists liquid or resists vapor. The Examiner has stated that "the colorant of Otaki inherently absorbs light" and that by absorbing light the "product is protected from long term degradation from exposure to light." The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic. MPEP §2112(IV) citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Thus, even if the colorant of Otaki might stabilize light, resist liquid or resist vapor, it is nevertheless insufficient to support a rejection under 103(a) since these are not characteristics necessarily present in colorants. See *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). All colorants are different. Since the Examiner has based the rejection of Claim 1 on inherency without providing evidence tending to show inherency of the missing descriptive matter, this rejection cannot stand and should be withdrawn.

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Nevertheless, Applicant submits that the colorant of Otaki is not equivalent to the claimed additives. There is nothing in Otaki to teach or suggest that the colorant is also an additive configured for one of light stabilization, liquid resistance or vapor resistance. Moreover, the present application distinguishes between different types of additives. For example, on page 8 beginning on line 15, the specification lists various types of additives including colorants, separate and apart from light stabilizers, liquid resistance additives and vapor resistance additives. The fact that these additives are listed individually indicates that they are separate and distinct additives, and that one of the additives does not necessarily possess the same characteristics as the other additives. In fact, it is clear from the Applicant's specification that certain colorants would not qualify as this claim element, further distinguishing the claimed invention over the prior art.

Light stabilization additives are not defined in the present specification as colorants, but rather are described as materials such as hindered amines, UV absorbers, etc. Liquid resistance additives decrease the wettability of the surface to specific liquids, and vapor resistance additives include acrylonitrile copolymers and vinylidene chloride copolymers. None of these elements are colorants. Moreover, a colorant does not inherently stabilize light, resist liquid or resist vapor *per se*. Accordingly, Otaki does not teach or suggest an additive configured for one of light stabilization, liquid resistance, or vapor resistance, as defined by the Applicant.

Coates does not make up for this deficiency. In fact, Coates does not teach or suggest adding a colorant to the metal hologram, as is acknowledged by the Examiner on Page 3, paragraph 6 in the August 31, 2007 Office Action. More importantly, Coates does not teach or suggest adding any additive to the layers of the hologram, let alone an additive configured for one of light stabilization, liquid resistance, or vapor resistance. Accordingly, neither Otaki nor Coates alone or in combination teach or suggest the claimed limitation of an additive configured for light stabilization, liquid resistance, and/or vapor resistance.

Claim 14

A *prima facie* case of obviousness has not been presented for claim 14 for lack of teaching of each and every element of the claim. Specifically, neither Otaki nor Coates teach a metallic foil. A metallic foil, as commonly known, is an independent, thin sheet of self-supporting metal that is separate and distinct from the other layers (page 7, lines 17-18).

Claim 14 specifically claims a metallic foil layer. Foils should not be confused with metallic layers that are deposited on substrates, and which are not independent or self-supporting.

Otaki teaches only a hologram, and therefore, does not teach a metallic foil. Coates teaches metallic holograms comprising a thin layer of metal, which is always formed and mounted on a substrate (Abstract). Unlike the claimed foil, the metallic layer of Coates is necessarily very thin and is fabricated or deposited on a die or substrate which is then used for transferring purposes (See col. 2, lines 6-11). The methods of Coates, such as vacuum metallization, sputtering and vacuum depositing the thin layer of metal, would not create a foil (col. 2, lines 6-7, 15-17, and 27-29). The metal layers of Coates are not layers of foil, i.e., independent of the other layers and self-supporting metal, but rather are always formed and mounted on a substrate (Abstract, and col. 2, lines 8-10, 18-22, and 29-31).

The Examiner argues that there is nothing in Coates that suggests that the metal layer of Coates is not self-supporting after it has been formed. Respectfully, Applicant disagrees with the Examiner on this point. The fact that the metal layer of Coates is always formed and mounted on a substrate is evidence that it is not independent from the substrate and is also evidence that it is too thin to support itself, and thereby does not qualify as a metallic foil. In addition, Coates expressly teaches extreme thinness of the metal hologram, and even states that:

"[T]his thinness is necessary... because the metal surface which was not in contact with the die surface will ultimately be the reflective holographic surface; and if the metal is much thicker, it will not adequately reproduce the detailed topology of the holographic master from which the die was fabricated." (col. 2, lines 42-49).

Contrary to the Examiner's position, Applicant submits that the facts discussed above do suggest that the metallic layer of Coates is not self-supporting after it has been formed. The Examiner argues that Coates is combined with Otaki to teach the use of a metallic hologram layer and not to teach the thickness of the hologram layer. Regardless of the purpose in combination, neither Coates nor Otaki teach a metallic foil. To reiterate, a metal foil is a layer that is independent and self-supporting. The procedures and methods taught in Coates necessarily prevent formation of a metal or holographic layer that is either independent or self-supporting. As such, Coates does not teach a metal foil.

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As neither Coates nor Otaki teach a metallic foil layer, they do not teach each and every element either alone or in combination. Therefore, withdrawal of the rejection is requested.

Claims 36-48

A *prima facie* case of obviousness has not been presented for claims 36-48 for lack of teaching each and every element of the claim. Specifically, neither Otaki nor Coates teaches an image-free metallic layer, as is required in independent claim 36. In fact, Otaki does not even teach a metal hologram, as is acknowledged by the Examiner on Page 7 of the March 18, 2008 Office Action. Accordingly, without a metal hologram, Otaki cannot possibly have an image free metallic layer.

Coates does not make up for this deficiency. The Examiner alleges that the metallic layer of Coates is not imaged or embossed at all times. In support of this allegation, the Examiner references col. 2, lines 5-15 of Coates, which describe one method of fabricating the metal hologram. The method described is that of vacuum depositing a metal layer directly on the die. Despite the Examiner's allegation that there is a point during this process whereat the metallic layer is not imaged or embossed, this physically cannot be the case in view of the following considerations.

Coates expressly teaches in the summary that the metallic reflecting hologram is prepared by use of a die having a holographic image formed in the embossing surface thereof. Thus, the die comprises an image thereon. At the moment that the metal layer is applied to the die, which occurs via vacuum deposition in the embodiment cited by the Examiner, it takes the holographic image of the die. As such, Coates does not teach any embodiment wherein the metallic layer is not imaged or embossed.

Coates does teach a metallic layer, but the metallic layer of Coates is a metallic hologram. A hologram is generally known and accepted as a type of image, and thus by its very nature a metallic hologram comprises an image. Moreover, Coates expressly teaches an image replicated into a metallic film (col. 1, lines 31-32). Therefore, the metallic layer of Coates is not image-free.

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As neither Cloates nor Otaki teach an image-free metallic layer, they do not teach each and every element either alone or in combination. Therefore, withdrawal of the rejection is requested.

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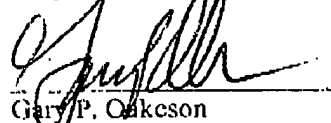
CONCLUSION

It is respectfully submitted that the rejections of the presently pending claims be reconsidered and withdrawn and that all claims be allowed. In view of the foregoing, Applicants believe that claims 1-5, 7-14 and 36-49 present allowable subject matter and allowance is respectfully requested.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025

Dated this 19th day of May, 2008.

Respectfully submitted,



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